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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

12/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/933,715	Applicant(s) TAKAHASHI ET AL.	
	Examiner Daniel Kesack	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,9-12 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9-12 and 15-1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's response filed August 27, 2008. The amendments have been entered and Applicant's arguments have been fully considered. Claims 1-3, 5-7, 9-12, and 15-17 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-3, 5-7, 9-12, and 15-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Storey, U.S. Patent No. 6,009,412, in view of Davis, U.S. Patent No.

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6,105,008, in view of Matsumoto, U.S. Patent No. 5,992,738, in view of Cybul et al., U.S. Patent No. 6,415,261.

Claims 1, 11, Storey teaches a communication system and method, comprising:
a first management apparatus for managing and settling a first transaction and generating a first privilege information generated in accordance with the first transaction the first transaction being a virtual transaction, the virtual transaction being a transaction conducted between the first management apparatus and a user terminal, located at a remote location, without a point-of-sale terminal via a network (column 4 line 66 – column 5 line 11, and column 5 lines 44-54), using a user identifier that identifies the user in such a manner that the first privilege information and the user identifier are correlated with each other (column 7 lines 50-60).

Storey fails to teach the use of an IC card.

Davis teaches an internet payment system using a smart card, where the user identifier is stored in a smart card and uniquely associates the user to the smart card (column 21 lines 31-57), where the transaction is made using the smart card in conjunction with the user terminal (column 10 line 59 – column 11 line 16). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Storey to include the use of the smart card as described by Davis because Storey contemplates payments, and Davis teaches using an IC card for

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paying for goods over the internet. The elements of the claimed invention were known at the time of Applicant's invention, and the results were predictable.

Storey and David fail to teach a second management apparatus.

Matsumoto teaches a second management apparatus for managing and settling a second transaction, the second transaction being a real world transaction, the real world transaction being a transaction conducted between the second management apparatus and the user via a point-of-sale terminal, wherein the second transaction includes a settlement processing based on the user identifier and a price, and is made using an IC card in conjunction with the point-of-sale terminal (column 8 line 26 – column 9 line 7). Matsumoto further teaches the transaction is only carried out if there is a sufficient balance, which is considered a credibility or a contribution of the user in the real world (column 4 lines 31-39). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Storey and Davis to include the second management apparatus because Cybul teaches a system and method for managing frequent shopper programs for users who shop on-line over the internet, as well as in the physical store (abstract). Cybul teaches an in-store POS device which converts information from an internet shopping history server into information which is used to reward loyal shoppers. Based on the Cybul disclosure, one of ordinary skill in the art would appreciate the benefits of integrating an online (or virtual world) shopping system with an in-store (or real world) shopping system. Storey and Davis combine to provide an internet shopping system (such as described by Cybul in

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figure 1, #18) which incorporates IC cards, and Matsumoto describes a POS system (such as described by Cybul in figure 1, #12) which incorporates IC cards. Cybul provides a teaching to integrate the two systems for the purpose of a customer loyalty program which reflects all of a user's purchases, both online and offline. According to the teachings of Cybul, the second management apparatus converts the first privilege information that is managed by the first management apparatus (on-line shopping history) into privilege information managed by the second management apparatus (column 5 lines 13-38) according to a prescribed conversion factor (a factor of 1, because the e-commerce shopping history is imported and treated the same as the POS shipping history), and manages the information obtained by the result of the conversion, such that the first privilege information is automatically converted to the second privilege information and added to a total of the second privilege information for the user when the user conducts transactions in the virtual world (column 5 lines 35-38).

Claims 2, 7, 15, Storey teaches the privilege information is an addable point, issued by the first management apparatus, as cited above.

Claim 3, Storey teaches the first privilege information is associated with a maximum amount of money that the user can use (column 8 lines 34-46).

Claims 5, 12, as cited above both Storey and Matsumoto teach points.

Claims 6, 10, 17, see the discussion of Matsumoto in relation to claim 1, above.

Claim 9, 16, Storey teaches the first management apparatus provides the privilege information in accordance with a credibility of the user (column 5 lines 1-43).

Response to Arguments

5. Applicant's arguments with respect to claims 1-3, 5-7, 9-12, and 15-17 have been considered but are moot in view of the new grounds of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Business World article "Citibank, Cathay Pacific launch new credit card" is cited for its teaching of a conversion of reward points from one system to another.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack
December 11, 2008
/D. K./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691